

REMARKS

Reconsideration of this application is respectfully requested. Petition is hereby made for a three-month extension of time to respond to the outstanding Office Action of March 9, 2009.

Claims 1 – 21 are pending in the application. Upon entry of this Amendment, claims 1, 3-6, 10-16, 20 and 21 will be amended, and new claims 22-36 will be added.

In the outstanding Office Action, the Examiner rejected claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite, arguing that it is unclear as to what is being claimed here. Given the amendments to claims 1 and 5 in this Amendment, it is believed that the rejection of claim 5 under §112, second paragraph, should now be withdrawn.

The Examiner also rejected, as being unpatentable under 35 U.S.C. §103(a), claims 1-4, 6, 8, 10, 12-14, 16, 18 and 20-21 over Kolbert (US 4,985,922) in view of Zarinetchi (USP 6,324,430), claims 5, 7, 11, 15 and 17 over Kolbert in view of Zarinetchi “as applied above”, and claims 9 and 19 over Kolbert in view of Zarinetchi and further in view of Winkler (USP 5,527,348). The Examiner’s rejections are respectfully traversed.

For a claimed invention to be obvious over a combination of prior art references, there must be some reason that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. Here, even assuming, *arguendo*, that the Examiner properly combined the cited references, the claimed invention is not obvious over such references because they fail to disclose all of the features recited in the rejected claims.

Kolbert, the primary reference cited by the Examiner in his §103(a) rejection, purports to disclose an inductive coupling for signal and power transmission through a wall of an aircraft. Although Kolbert states that the coupling magnetically transfers "data and circuit power to an aircraft security code storage circuit," Kolbert, col. 1, lines 46 – 47, he also states that "a similar technique and attendant devices may be employed to complete electrical signal or power transfer through any relatively thin walled structure", Kolbert, col. 1, lines 65 - 68.

Kolbert's coupling device includes a sending unit 14 with a magnetic ring 24 "for permitting detachable mounting to the wall." *See, e.g.*, Kolbert, col. 4, claim 1. Thus, it would appear that, during operation, Kolbert's sending unit is not intended to be held by an operator's hand, but is held to a wall 16 by magnetic forces. Hence, in Kolbert, the problems associated with operating a hand-held sending unit do not exist, since no bad sensations will thus occur in an operator's hand while the sending unit device is generating an alternating magnetic field.

Kolbert's sending unit 14 has a ferromagnetic housing 22 and a ferromagnetic coil form 26 that is disposed inside the housing and serves as a core for a winding 28. Kolbert fails to disclose that the housing is integrated with the core, as recited in amended independent claim 1 of the present application, as evidenced by the fact that this feature is not described in the text of Kolbert's patent, and not visible in Kolbert's drawings.

Kolbert also does not describe his housing 22 and core 26 as a shield. To the contrary, Figure 2 of Kolbert depicts the magnetic flux lines 40 passing outside the

housing 22 and extending up to relatively large distances from the housing 22. It can be contended that the housing is only used for reinforcing the magnetic coupling between the sending unit 14 and the pick-up unit 19.

The Examiner seeks to combine the teachings of Kolbert with Zarinetchi on the ground that Zarinetchi compensates for the noted deficiency in the teachings of Kolbert by disclosing the use of a transfer system with an implanted medical device through a medium of skin. Zarinetchi purports to disclose a transcutaneous energy transfer device having a magnetic shielding plate that is disposed on the rear side of a flat coil, the device lacking a magnetic winding core.

Applicant contends that one of ordinary skill in the art would not have looked to combine Kolbert with Zarinetchi because Kolbert is in the field of transferring signals and power for typical non-human applications, while Zarinetchi deals with transferring energy to an implanted device. Moreover, in the present invention, the implanted coil can be located rather deeply inside a patient's body, as seen, for example, in Figures 6 and 7 of the present application, whereas, in Zarinetchi, the secondary coil 12 is located just underneath the skin, *see, e.g.*, Zarinetchi, Figure 1, and, in Kolbert, the pick-up unit 19 is located at "the interior surface of the aircraft skin", *see, e.g.*, Kolbert, col. 2, lines 45 - 48.

Applicant also contends that even if one of ordinary skill in the art would have looked to combine Kolbert with Zarinetchi, the result would not be the transmission device described in amended claim 1, since (1) a shield having a portion surrounding the

circumference of the coil along at least a portion of the longitudinal extension of the coil is not disclosed in any of the documents, and (2) a shield comprising a core integrated with a housing is not disclosed in any of the documents.

Hence, Applicant further contends the subject matter of amended independent claim 1 is not obvious over a combination of Kolbert and Zarinetchi. And since the features described in amended independent claim 1 are also described in amended independent claims 10, 11, 20 and 21 of the present application, Applicant contends that these claims are also not obvious over a combination of Kolbert and Zarinetchi.

With regard to the Examiner's rejection of claims 5, 7, 11, 15 and 17 under §103(a) as being obvious over Kolbert in view of Zarinetchi "as applied above", the Examiner first recognizes, with regard to independent claim 11, that these references in combination do not disclose the use of two transmitters. Nevertheless, the Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the system of Kolbert in view of Zarinetchi with the use of two transmitters since "such a modification would provide the predictable results of ensuring efficient recharging of [an] implanted medical device that is located internally and migrates by diametrically opposition of the transmitters such that the implant will be located in between the two and at least one transmitter will be able to more efficiently couple." 3/9/09 Office Action, p. 4. The Examiner next recognizes, with regard to claims 5, 7, 15 and 17, that Kolbert and Zarinetchi fail to teach a core longitudinally extending beyond the length of a shield and cut-out slots on the sides of the shield. Nevertheless, the Examiner again

argues that it would have been obvious to one of ordinary skill in the art to modify the system of Kolbert in view of Zarinetchi "with providing [sic] cut-out slots on the side of the shield which would yield a system where the core and coil windings extend longitudinally beyond the shield for providing the predictable results of providing ventilation for the skin surface and dissipation of any excess heat energy stored within the shield member." 3/9/09 Office Action, pp. 4-5.

However, the Federal Circuit has held that when an Examiner makes a patentability determination that a claimed invention is obvious over the prior art, the Examiner must rely on "concrete factual evidence" to make the factual findings to support a §103(a) rejection. *See In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001). The *Zurko* decision requires an Examiner to provide concrete factual evidence to support his determination that the rejected claims are not patentable because they are obviousness over the cited prior art.

In *Zurko*, the claimed invention was directed to a method for more efficiently creating a secure or "trusted" computer environment. The Examiner rejected the claimed invention under 35 U.S.C. §103, relying on a combination of two prior art references, *i.e.*, the UNIX Operating System ("UNIX") and a program (Dunford, FILER Version 2.20 ("FILER 2")) for repeating potentially dangerous commands before execution. In sustaining the rejection, the Patent Office Board of Appeals "contended that even if the cited UNIX and FILER 2 references did not disclose a trusted path, 'it is basic knowledge that communication in trusted environments is performed over trusted paths' and,

moreover, verifying the trusted command in UNIX over a trusted path is 'nothing more than good common sense.'" *Zurko*, 258 F.3d at 1385. On appeal, the Federal Circuit rejected the Board's contentions, holding:

With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Zurko, 258 F.3d at 1385-86. (Emphasis added).

The same is true with respect to the Examiner's rejection of claims 5, 7, 11, 15 and 17 under §103(a) as being obvious over Kolbert and Zarinetchi and relying on “predictable results”. Clearly, it is not proper for the Examiner to rely on the above-noted assertions of “predictable results” to support his §103(a) rejection of these claims. Rather, the Examiner must point to some “concrete evidence in the record” to support his assertion of obviousness. This he has not done. Thus, unless the Examiner supplements the record in this application to further support his §103 rejections of claims 5, 7, 11, 15 and 17, as required by *Zurko*, for this reason alone, such claims should be allowable.

With regard to amended independent claim 11 and new independent claim 33, each of which describes two transmitters, Applicant further asserts that it would not have been obvious to one of ordinary skill in the art to modify devices and methods disclosed in Kolbert or Zarinetchi for the reason mentioned above that, in the present invention, the receiver or implanted coil can be located deeply inside the body. Applicant notes that for Kolbert and Zarinetchi, the use of two different magnetic fields would not have any

reasonable function, since their pick-up unit and secondary coil are located very close to, and aligned with, their sending unit and primary coil, respectively. Applicant further notes that, in Kolbert there is an automatic aligning effect due to the ring magnets (14), and in Zarinetchi the primary coil is larger than the secondary, this effectively preventing any indication that two "transmitters" could be used.

With regard, specifically, to the Examiner's rejection of claims 9 and 19 under §103(a) over Kolbert, Zarinetchi and Winkler, because the Examiner is essentially repeating, in this rejection, his reasons for citing Winkler, as explained in the prior Office Action of June 25, 2008, Applicant repeats and incorporates specifically by reference the reasons and arguments set forth in the Response filed December 22, 2008 as to why Winkler does not help to render claims 9 and 19 obvious over the cited art.

Finally, since independent claims 1, 10, 11, 20, 21 and 33 are not obvious over the combination of references cited by the Examiner, dependent claims 2-9, 12-19, 22-32 and 34-36 are also not obvious over the combination of such references.

In view of the foregoing, it is believed that all of the claims pending in the application, *i.e.*, claims 1 – 36, are now in condition for allowance, which action is

FORSELL, Peter
Application Serial No. 10/527,989

earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: Robert A. Molan

Robert A. Molan

Reg. No. 29,834

RAM:drt

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100